UNITED STATES PATENT AND TRADEMARK OFFICE

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10/584,649	06/26/2006	Dirk Gandolph	PD040002	8142

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Thomson Licensing LLC
P.O. Box 5312
Two Independence Way
PRINCETON, NJ 08543-5312

EXAMINER
DASGUPTA, SOUMYA

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/584,649	GANDOLPH ET AL.
	Examiner	Art Unit	
	SOUMYA DASGUPTA	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2009*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 12-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 12-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

Applicant's Response

In the applicant's response for application 10/584,649 dated 9/26/2008, the applicant

amended Claims 1, 5, 13, 15, and 17; and argued against all the rejections and

objections.

The rejection set forth under 35 USC 112 (1st) for Claims 1-20 is withdrawn because the

appellant amended the claim to recite "page number."

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 5 and 17:

Claims 5 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the

The phrase "wherein number from among the available menu pages within the

defined range, the menu page with the next higher page number relative to the page

number of said first menu page is selected if the numeric value indicates a higher page

number than the page number of the first menu page" is confusing, poorly worded, and

not clearly understood by one of ordinary skill in the art. *In order to clarify the subject*

matter, the examiner recommends that the applicant amend the claim to positively recite

the limitation so that it is <u>clearly understood</u> (emphasis added) by one of ordinary skill in

the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by

Goldsmith et al (US 2005/0076309; PG Pub Date: April 7, 2005; Patent Filing Date: Oct

3, 2003; hereafter Goldsmith.)

Claim 1:

Goldsmith discloses:

A method for automatically generating an electronic menu including a plurality of

menu pages, wherein menu pages contain selectable menu items with associated

commands to be executed upon activation of the respective menu item, the

method comprising: (Fig 5→ Goldsmith discloses "automatically generating an

electronic menu including a plurality of menu pages" in that a list of categories are

produced in a menu-like system. Fig 5 → Goldsmith discloses "menu pages contain

selectable menu items with associated commands to be executed upon activation of the

respective menu item" in that the user can click on the hyperlink from the tree-menu.

wherein associating a page number with each menu page; (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses this limitation in that each menu selection has a pointer associated with it. The forward pointer allows navigation to a successive menu and the backward pointer allows navigation to a pervious menu. According to Fig 5, the user can navigate between successive and previous menus. Moreover, the examiner notes that "page numbers" are functionally equivalent to pointers to other menus because the applicant is referring to *Fig 1, item 14 of the application* as the " page number" (Playlist #xxxx). The Playlist numbers refers to the current menu and points successive and previous menus pending on the user's selection.)

a first menu page containing at least one menu item with an associated command and associated data, wherein the command associated with the menu item comprises switching to another menu page; (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "a first menu page containing at least one menu item with an associated command and associated data, wherein the command associated with the menu item comprises switching to another menu page" in that the user can select the items from a menu to either view more submenus or initiate a command for a function. According to Fig 5, the user can navigate between successive and previous menus. Moreover, the examiner notes that "numeric page numbers" are functionally equivalent to pointers to other menus because the applicant is referring to *Fig 1, item 14 of the application* as the "numeric page number" (Playlist #xxxx). The Playlist numbers refers

to the current menu and points successive and previous menus pending on the user's

selection.)

defining a range of page numbers based upon said data associated with said

command; (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses this limitation

in that the menu contains a list of selections of a sub-menu because the page numbers

are functionally equivalent to pointers that designate a selection or a new sub-menu.

The examiner interprets "range of page number" to be of selection items on the current

menu. Since "page numbers" are functionally equivalent to pointers of the listed

selections items on the menu, then the listed selection items on the menu are

functionally equivalent to a "range of page numbers" or a range of pointers.)

detecting the page numbers of the available menu pages; (Fig 5 → Goldsmith

discloses "detecting the page numbers of the available menu pages" in that the

whenever a new selection is made, the pointer detects and points to the new menu

page so that the new menu can be opened. If a pointer was not available, the new

menu selected would not be able to open.)

and selecting a second menu page upon activation of said menu item for

switching to another menu page, (Fig 5, Paragraphs [0010] and [0011] → Goldsmith

this limitation in that the user can select a menu item that can open another menu

page.)

wherein the second menu page has the first or last page number from among the available menu pages within the defined range of menu pages (Fig 5, Paragraphs [0010] and [0011] → Goldsmith this limitation in that the user can select a menu item that can open another menu page. The selected menu can have a pointer to the first menu or be a child menu without any offspring.)

and wherein the first and second menu pages are retrieved from different storage media. (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "the first and second menu pages are retrieved from different storage media" in that the audio player, QuickTime player, and camera tools can be from different storage devices.)

Claim 2:

Goldsmith discloses:

Method according to claim 1, wherein defining a range of page numbers is also based upon the page number of said first menu page. (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "defining a range of page numbers is also based upon the page number of said first menu page" in that the menu contains a list of selections of a sub-menu because the page numbers are functionally equivalent to pointers that designate a selection or a new sub-menu. The examiner interprets "range of page number" to be of selection items on the current menu. Since "page numbers"

are functionally equivalent to pointers of the listed selections items on the menu, then

the listed selection items on the menu are functionally equivalent to a "range of page

numbers" or a range of pointers. The user can select the first menu by selecting "launch

app>" (see Fig 5).)

Claim 3:

Goldsmith discloses:

Method according to claim 2, wherein said range is further defined by a page

number of another menu page that is stored on the same storage medium as the

first menu page. (Fig 5 → Goldsmith discloses "range is further defined by a page

number of another menu page that is stored on the same storage medium as the first

menu page." in that the whenever a new selection is made the menu of the application

can be from the same storage device.)

Claim 4:

Goldsmith discloses:

Method according to claim 1, wherein said range is defined by a placeholder

within said data associated with said command. (Fig 5 → Goldsmith discloses

"range is defined by a placeholder within said data associated with said command" in

that the pointer is programmed into memory so that the user can select the appropriate

navigation options.)

Claim 5:

Goldsmith discloses:

Method according to claim 1, wherein said data associated with said contain a numeric value and wherein the range of page numbers is defined by the numeric value and the page number of said first menu page, (Fig 5, Paragraphs [0010] and [0011] → Goldsmith discloses "data associated with said contain a numeric value and wherein the range of page numbers is defined by the numeric value and the page number of said first menu page" in that the pointers can be designated with alpha-numeric code.)

and wherein number from among the available menu pages within the defined range, the menu page with the next higher page number relative to the page number of said first menu page is selected if the numeric value indicates a higher page number than the page number of the first menu page. (Fig 5, Paragraphs [0010] and [0011] → Examiner Interpretation: Goldsmith discloses this limitation in that the user can select successive or previous menus. According to Figure 13 of the Application, the "higher page numbers" are the successive menus of the root menu and the "lower page number" are the root menu.)

Claim 6:

Goldsmith discloses:

Method according to claim 1, wherein a menu page is stored in a separate file, or in a selectable portion of a file, and the page number is determined by the name of the file, or by the name of the file and the selectable portion within the file, in which it is stored. (Fig 5 → Goldsmith discloses "menu page is stored in a separate file, or selectable portion of a file, and the page number is determined by the name of the file, or the name of the file and the selectable portion within the file, in which it is stored" in the hardware in the computer stores the menu is a cache memory or permanent storage either within the software itself or in a separate file designating a menu.)

Claim 7:

Goldsmith discloses:

Method according to claim 1, wherein the page number associated with the first or second menu page depends on user specific settings. (Fig 5 and 7 → Goldsmith discloses "the page number associated with the first or second menu page depends on user specific settings" in that the user can select the item on the menu that is specified to the user's settings. The user's settings can select features that can be added to the menu. Fig 7, item 504 → "Personal Info Manager" and "System")

Claim 12:

Goldsmith discloses:

Method according to claim 1, wherein detecting of the page numbers of the

available menu pages includes detecting if the corresponding AV content

selectable from said menu page is also available. (Fig 5; Fig 7, item 504 →

Goldsmith discloses " detecting of the page numbers of the available menu pages

includes detecting if the corresponding AV content selectable from said menu page is

also available" in that a multimedia feature such as QuickTime or Audio player can be

selected.)

Claim 13:

Claim 13 corresponds to Claim 1.

Claim 14:

Claim 14 corresponds to Claim 5.

Claim 15:

Goldsmith discloses:

Optical storage medium for storing audio-visual content and menu data for a

multi-page menu, wherein menu pages have page numbers, and wherein at least

a first menu page contains a command for selecting a second menu page, (Figs 5

and 7; Paragraph [0010] and [0011] → Goldsmith discloses this limitation in that the AV

data can be selected from the menu and the root menu contains a selection that can

navigate to the second page.)

wherein the command for selecting a second menu page specifies a range of two

or more menu pages to select, and a predefined rule specifies which menu page

of the range of menu pages is selected next; (Figs 5 and 7; Paragraph [0010] and

[0011] → Goldsmith discloses this limitation in that each menu selection has a pointer

associated with it. The forward pointer allows navigation to a successive menu and the

backward pointer allows navigation to a pervious menu. According to Fig 5, the user can

navigate between successive and previous menus. Moreover, the examiner notes that

"page numbers" are functionally equivalent to pointers to other menus because the

applicant is referring to *Fig 1, item 14 of the application* as the " page number" (Playlist

#xxxx). The Playlist numbers refers to the current menu and points successive and

previous menus pending on the user's selection.)

and for at least one page number within said range no relating menu page is

stored on the optical storage medium. (Figs 5 and 7 → Goldsmith discloses "at least

one page number within said range no relating menu page is stored on the optical

storage medium" in that hardware in the computer stores the menu is a cache memory

or permanent storage either within the software itself or in a separate file designating a

menu. The examiner notes that the limitations refer to data NOT being stored.)

Claim 16:

Claim 16 corresponds to Claim 4.

Claim 17:

Claim 17 corresponds to Claim 5.

Claim 18:

Claim 18 corresponds to Claim 6.

Claim 19:

Claim 19 corresponds to Claim 7.

Claim 20:

Claim 20 corresponds to Claim 12.

Response to Arguments

Claim (5 and 17) Rejection under 35 USC 112 (2nd Paragraph):

The appellant argues that the limitation "wherein number from among the available

menu pages within the defined range, the menu page with the next higher page number

relative to the page number of said first menu page is selected if the numeric value

indicates a higher page number than the page number of the first menu page" is not

confusing and the rejection should be withdrawn. The appellant attempts to further

clarify the meaning on the limitation on the Applicant's Arguments (pg 5-6) dated

12/10/2008.

The examiner disagrees.

The examiner has noted the appellant's attempt to clarify the meaning of the limitation,

the limitation as currently recited is still confusing and not easily understood by one of

ordinary skill in the art; however, the explanation of this confusing limitation is not

sufficient and does not obviate a 112(2nd paragraph) rejection. The examiner HIGHLY

RECOMMENDS that the appellant amend the limitation in order to CLARIFY its

meaning.

Claim (1-7 and 12-15) Rejection under 35 USC ~ 102(b):

Applicant's arguments filed 12/10/2008 have been fully considered but they are not

persuasive. For Claims 1, 13, and 15, the appellant argues that Goldsmith (US

2005/0076309) does not disclose "associating a page number with each menu page"

wherein (i) the PlayList #xxxx is not functionally equivalent to pointers, (ii) the page

numbers have an implicit or intrinsic order, wherein the order will allow pages to be

automatically positioned in correct order when inserting and deleting pages - which is

different from pointers and links because they require modification, and (iii) the

"previous" and "next" commands refer to a natural sequence of numbers instead of

navigating a hierarchical menu. Moreover, "previous" and "next" commands can be

used to navigate the current level of the menu.

The examiner disagrees.

(i) The applicant argues that in page 9, lines 4-9 of Specification, PlayList and play-item

numbers are not the same because the word PlayList is a part of item 14. On page 9,

lines 4-9 recite of the Specification recites: *"In FIG. 1, playlist and play-item numbers 14,*

15, 16 label every menu frame 10, 11, 12. This is the entry point by which the interactive

graphical stream can be found within the transport stream. E.g. the main menu page 10

can be stored in the playlist file "03000.mpls", as indicated in FIG. 1 by the respective

playlist and play-item number 14." The PlayList comprises of the play-item number, Item

14; hence, the PlayList is a part of item 14.

Moreover, the claim language recites "associating a page number with each menu

page." In Fig 1, when the user selects "Audio" (item 13), the system then selects a new

menu (item 11) referred to by PlayList #03200 (item 15). PlayList#03200 points to or

references the new sub-menu; hence, "associating a page number with each menu

page." If PlayList#03200 was not a pointer, then the text "PlayList #03200" would only

print and the sub-menu would not print because there would no "associating a page

number with each page menu" involved. Hence, the PlayList and the play-item number

corresponds to a pointer.

Also, the Specification on page 9, lines 4-7 state that *playlist and play-item numbers*

14, 15, 16 label every menu frame 10, 11, 12. This is the entry point by which the

interactive graphical stream can be found within the transport stream." This clearly

refers to a PlayList functioning equivalently as a pointer because the PlayList and the

play-item number refers to a menu and then serves as the entry post for the GUI.

(ii) The applicant argues that the page numbers have an implicit or intrinsic order,

wherein the order will allow pages to be automatically positioned in correct order when

inserting and deleting pages - which is different from pointers and links because they

require modification. However, the claim language does not recite this feature. In

response to applicant's argument that the references fail to show certain features of

applicant's invention, it is noted that the features upon which applicant relies (i.e., have

an implicit or intrinsic order) are not recited in the rejected claim(s). Although the claims

are interpreted in light of the specification, limitations from the specification are not read

into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.

1993). *The examiner recommends that the applicant positively recite these features in*

the claim.

(iii) The applicant argues that the "previous" and "next" commands refer to a natural

sequence of numbers instead of navigating a hierarchical menu. Moreover, "previous"

and "next" commands can be used to navigate the current level of the menu. However,

the claim language does not recite this feature. In response to applicant's argument that

the references fail to show certain features of applicant's invention, it is noted that the

features upon which applicant relies (i.e., natural sequence of numbers) are not recited

in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). *The examiner recommends that the*

applicant positively recite these features in the claim.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the

entry of the submission under 37 CFR 1.114 and could have been finally rejected on the

grounds and art of record in the next Office action if they had been entered in the

application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE**

FINAL even though it is a first action after the filing of a request for continued

examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to SOUMYA DASGUPTA whose telephone number is

(571)272-7432. The examiner can normally be reached on M-Th 9am-7pm, F 9am-

1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SD

/DOUG HUTTON/
Supervisory Patent Examiner, Art Unit 2176